



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/537,493	06/03/2005	Hiroshi Horiuchi	Q88366	4639
65565 7590 12/23/2008				
SUGHRUE-265550				
2100 PENNSYLVANIA AVE. NW				
WASHINGTON, DC 20037-3213				
EXAMINER				
BADR, HAMID R				
ART UNIT		PAPER NUMBER		
1794				
MAIL DATE		DELIVERY MODE		
12/23/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/537,493

Applicant(s)

HORIUCHI ET AL.

Examiner

HAMID R. BADR

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9/03/2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5,6 and 8-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5,6 and 8-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Applicants' amendment filed on 9/03/2008 is acknowledged.

Claims 5-6, and 8-13 are being considered on the merits.

Objection to Claims

Claim 6 is objected to for "shortened than". It is expected that "shorter" be used rather than "shortened". Correction is required.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 13 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicants statement that the "reduced concentration of dissolved oxygen is maintained during fermentation" is not supported by the subject matter at page 6, lines 1-10 and page 15, lines 1-4 as set forth by applicants.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 5-6 and 8-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. Claims 5 is indefinite. The phrase "a concentration of dissolved oxygen" makes the claim indefinite. It is not clear what is meant by "a concentration". It is not clear what the applicants regard as the invention.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 5-6 and 8-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Castberg et al. (US 5,453,256; hereinafter R1) in view of Kamiya (EP 1 082 907; hereinafter R2).
3. R1 discloses a method of converting pasteurized milk into fermented milk in which the pasteurized milk is carbonated with carbon dioxide and inoculated with starter culture. (Abstract).
4. R1 discloses that while the conventional yoghurt process employs 43C as the incubation temperature; an incubation temperature of 30C may be employed (Col. 3, lines 14-17).

5. R1 discloses the advantage of the invention as shortening the fermentation time necessary and can thus lead to economics of the fermented milk and is particularly applicable to yoghurt production (Col. 4, lines 29-34).
6. R1 teaches using 1200 ppm of carbon dioxide which stimulates the starter culture and as a result the incubation time is reduced by 20% (Col. 5, lines 5-10). Given the effect of lowering the oxygen content of the medium on the starter culture in reducing the incubation time, the finding, by the applicant, that the "increase of the lactic acid activity could be promoted without using any additives such as fermentation promoting substances by using inert gas to reduce the dissolved oxygen concentration" (Page 5 of the instant application, lines 10-21) is known in the art.
7. R1 gives an incubation temperature of 37C while using yoghurt starter cultures (Col. 8, Example IV)
8. R1 is silent regarding the dissolved oxygen concentration and how it can be monitored by using an inert gas.
9. R2 teaches using nitrogen to reduce the dissolved oxygen in milk. R2 teaches that in milk; the dissolved oxygen is about 10 ppm and in order to reduce it to about 2 ppm; one needs to add 40-50%, by volume, of nitrogen gas to the amount of milk (page 4, p 0023). R2 discloses that reducing the dissolved oxygen in milk will reduce smell and improve taste and smoothness (Abstract and Fig. 4).
10. Regarding claims 8-9, given that R1 in combination with R2 disclose method as presently claimed, it is clear that such method would intrinsically result in fermented milk

with excellent smoothness and taste as presently claimed as well as hardness as presently claimed.

11. Regarding claims 10-12; the gel strength in the final product may be measured by different means. For instance a penetrometer may be employed to test the gel strength. However, depending on the desired gel characteristics of the final fermented milk product e.g. yogurt, one of ordinary skill in the art may optimize the process for such parameters as milk solid contents, starter culture concentration, incubation temperature and duration of fermentation as well as the concentration of such compounds as gelatin or starch added at the beginning to the milk base. The parameters such as penetration angle and hardness are absolutely unusual in the art and obviously could be replaced by other more meaningful parameters for the determination of gel strength. Given that R1 in combination with R2 disclose method as presently claimed, it is clear that such method would intrinsically result in fermented milk with penetration angle and hardness as presently claimed.

12. Regarding claim 13, given that R2 reduces the concentration of dissolved oxygen in the fermentation medium to about 2 ppm, resulting in quality attributes such as taste, aroma and smoothness of texture, it is clear that the low dissolved oxygen is maintained during the fermentation.

13. It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the teachings of R1 and adopt the teachings of R2 in using an inert gas to reduce the dissolved oxygen in the milk medium to accelerate the growth of the starter culture and hence reduce the incubation time as presently claimed.

One would do so to benefit from processes which may be carried out on a continuous basis and having a shorter fermentation time, the overall economics of the process will be improved. Absent any evidence to contrary and based on the combined teachings of the cited references, there would be a reasonable expectation of success in making a fermented product using an inert gas.

Response to Arguments

Applicants' remarks/arguments have been thoroughly reviewed. However, they do not deem persuasive.

1. Applicants argue that one skilled in the art would not have been motivated to combine R1, teaching the use of carbon dioxide, with R2, teaching the use of nitrogen, to prepare a fermented milk as presently claimed.
 - a. R1 teaches certain aspects of the presently claimed invention namely the reduction of dissolved oxygen in the fermentation medium and the lowered fermentation temperature due to effect of lowered oxygen tension. Both of these aspects are being presently claimed. It is obvious to those of skill in the art that addition of carbon dioxide will result in the formation of carbonic acid which lowers the pH and could affect the taste and the texture of the gel. This would have motivated a person of skill in the art to look for some hints to replace carbon dioxide with an inert gas such as nitrogen. This is remedied by using the teachings of R2 by using nitrogen to lower the dissolved oxygen

in the fermentation medium and additionally lower the dissolved oxygen in the fermentation medium to the levels set by R2.

2. Applicants argue that the products obtained by the claimed methods exhibit unexpected results which were not obtained by conventional methods.

a. It should be realized that methods disclosed by R1 and R2 are not conventional methods of making fermented milk products because the conventional methods of making a gelled fermented milk do not reduce the dissolved oxygen in the fermentation medium by using inert gas. Consequently, the products obtained by the combined methods of R1 and R2 will intrinsically have the quality attributes such as taste, aroma, texture and smoothness as presently claim.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HAMID R. BADR whose telephone number is (571)270-3455. The examiner can normally be reached on M-T 5:30 to 4:30 (Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie Shosho can be reached on (571) 272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Hamid R Badr
Examiner
Art Unit 1794

/Callie E. Shosho/
Supervisory Patent Examiner, Art Unit 1794